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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,345

06/19/2006

Peter Kwok Hing Lam

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EXAMINER

ENG, ELIZABETH

ART UNIT

PAPER NUMBER

1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/583,345	<b>Applicant(s)</b> LAM ET AL.	
	<b>Examiner</b> ELIZABETH ENG	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/29/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Amendments**

1. Applicant's amendments filed 10/8/2009, wherein claims 1-15 have been canceled and new claims 16-34 are added, overcomes the 35 U.S.C. 112 rejection of the now cancelled claim 3 regarding a narrower limitation within a broader one.
2. Applicant's arguments, filed 10/8/2009, with respect to the rejection(s) of claim(s) 1-15 under 102 (b) have been fully considered and are persuasive. The Examiner agrees that Gothjaelsen et al. does not teach a "rubbery elastomeric matrix" but a non-memory mouldable mass, and Korpman does not teach a saturated hydrocarbon. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Vaanbengaard, further in view of Fattman, and further in view of Bellingham.

### **Specification**

3. The disclosure is objected to because of the following informalities:

[Page 9, line 5] : --10.000—should read –10,000--.

[Page 9, line 8]: --20.000 and 100.000- should read –20,000 and 100,000--.

[Page 12, line 10]: --300.000—should read –300,000---.

Appropriate correction is required.

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### 35 U.S.C. 103 Rejection

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 16-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaanbengaard et al. (US Pat. No. 6,558,792) further in view of Fattman et al. (US 2005/0080155).

8. Regarding claims 16-32, Vaanbengaard et al. teaches a pressure sensitive adhesive composition comprising a rubber elastomeric base, wherein the adhesive composition consists of a homogeneous mixture of 15-60% of one or more rubbery components (claim 27), 10-60% of a mixture of hydrocolloids (claims 28 and 29), 1-50% of tackifier resin (claim 30), and 0-15% of a cohesive strengthening agent [Abstract].

9. More specifically, in example 5, Vaanbengaard prepares an adhesive material comprising polyisobutylene (PIB) as the rubbery component (claim 23), a physically cross-linked (claim 21) [column 10, claim 5] styrene-isoprene-styrene (SIS) copolymer as the cohesive strengthening agent (claims 18-20 and 22) [column 6, line 66], and a mixture of hydrocolloids consisting of amidated pectin, potato starch, and carboxymethylcellulose (CMC) [column 7, Table 3].

10. Vaanbengaard further teaches the adhesive is used for the preparation of a wound dressing or an adhesive wafer (claims 31 and 32) [column 1, line 18].

11. Vaanbengaard teaches the cohesive strengthening agent is a styrene-isoprene-styrene copolymer wherein isoprene is a linear *unsaturated* hydrocarbon. Vaanbengaard is silent with respect to the styrene copolymer containing a linear *saturated* hydrocarbon having the same chemical structure as the rubbery polyisobutylene component. However, in the same field of endeavor of producing an adhesive for use in an ostomy device, Fattman et al. teaches using a styrene-

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isobutylene-styrene (SIBS) copolymer for the benefit of superior migration resistance [0058], or more specifically, resistance to the migration of intestinal fluid across the adhesively bonded interface [0025].

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce the adhesive composition of Vaanbengaard using the styrene-isobutylene-styrene copolymer of Fattman in order to produce an adhesive resistant to the migration of intestinal fluid across the adhesively bonded surface. The combination of Vaanbengaard and Fattman thus yields an adhesive containing a linear, saturated hydrocarbon having the same chemical structure as the rubbery polyisobutylene component in Vaanbengaard (claim 17).

13. The combination of Vaanbengaard and Fattman is silent with respect to the molecular weights of the styrene and linear saturated hydrocarbon in the copolymer (claims 24 and 25) as well as the molecular weight of the polyisobutylene (claim 26). However, Vaanbengaard uses the same polyisobutylene product as the instant invention [Page 15, bottom], wherein both inventions use Vistanex from Exxon Chemical Co. grade LM-MH [column 5, lines 46-47]. Fattman also uses the same styrene copolymer SIBSTAR 073T [Page 8, Table 10] as the instant invention [Page 15], wherein the copolymer has a molecular weight of 65,000 g/mol and a styrene content of 30% [Page 5, bottom of Table 4- Page 6, top of Table 4 continued]. Since both Vaanbengaard and Fatman use the same polymer products as the instant invention, there is reasonable basis to believe that the molecular weights of the styrene copolymer and the polyisobutylene of the prior arts are within the claimed ranges.

14. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaanbengaard et al. (US Pat. No. 6,558,792) in view of Fattman et al. (US 2005/0080155) as in claims 16 and 19 above, further in view of Bellingham et al. (US Pat. No. 5,109,874).

15. Regarding claims 33 and 34, Vaanbengaard teaches using an adhesive in a wound dressing [column 1, line 18] but is silent with respect to the wound dressing comprising a water-impervious backing layer or film. However, it is well known in the art for a wound dressing to containing a water-impervious film in order to protect the wound from wetness and infection. Bellingham et al. for example teaches a wound patch containing a gas and liquid impermeable member that is adhesively sealed to the skin around a wound to prevent the entering or exiting of gases and liquids through the wound, which allows the user to engage in physical activity without concern for contaminants entering or leaving the wound area. Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Vaanbengaard and Fattman with Bellingham for the benefit of protecting wounds from contamination.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH ENG whose telephone number is (571)270-

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7743. The examiner can normally be reached on Mondays through Fridays from 9:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Elizabeth Eng/

/David Wu/

Supervisory Patent Examiner, Art Unit 1796